

REMARKS

Examiner Goodrow is thanked for advising undersigned in a recent telephone conference that he would consider a Supplemental Amendment. Accordingly, claim 19 is amended above to add the feature of previous claim 12, such feature having also been added to claim 11 in the Reply filed July 10, 2008, consistent with the earlier telephone conference on or about June 24, 2008.

Applicants submit that claim 19 should be patentable for the same reasons as claim 11. Moreover, even though claim 19 is partly a product-by-process claim, it also contains structural and chemical features which make it more of a hybrid product-by-process claim. Clearly, these physical and chemical aspects must be given full weight.

As regards the process aspects, the Examiner's attention is respectfully invited to *In re Luck et al*, 177 USPQ 523, 525 (CCPA 1973), where the Court stated:

As for the method of application, it is well established that product claims may include process steps to wholly or partially define the claimed product. See *In re Brown*, ... 459 F.2d 531, 535, 173 USPQ 685, 688 (1972), and the cases cited therein. To the extent these process limitations distinguish the **product** over the prior art, they must be given the same consideration as traditional product characteristics. In the present case, we cannot agree with the Patent Office that the absence of the carrier in the final product renders the carrier immaterial.

The method of application could well result in a difference in the coated article, regardless of the fate of the solvent. [Emphasis in original]

Thus, it should be clear that the process recitations must also be given weight to the extent that they define or characterize the product. Applicants believe that it should be readily understood in the present case that the nature of the resultant product differs from similar products due to the process by which it has been made, as recited in claims 11 and 19.

Accordingly, applicants respectfully request not only allowance of claims 1, 2, 5-11 and 13-18, but also the allowance of claim 19.

Favorable consideration is respectfully requested.

Respectfully submitted,

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